

REMARKS

Subsequent to entry of the foregoing amendments, claims 1-4 and 6-14 are currently pending in this application. Claim 5 was previously cancelled, and claim 11 is hereby cancelled. New claims 12-14 are introduced via this Amendment.

Summarizing the Board's decision, Judges Pate, McQuade and Bahr confirmed the Examiner's assertion that elements 45a, 45b and 45c in Figs. 29-32 of *Moribayashi* disclosed the broadest reasonable interpretation of "cylinder portion" required by independent claim 1. The Board asserts that absent an element designating a "continuous" cylinder portion, a structure intermittently present about a circumference (*Moribayashi*, 45a and 45c) fully meets the limitation of "cylinder portion" recited in claim 1. (Decision page 3 citing *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 772; Decision pages 6-7.) The rejection of independent claim 11 was also confirmed by the Board, where the Board specifically points to bent portions 43 of yoke 41 in Fig. 33 as disclosing "bent portions that are formed by end portions of the case body" (Decision page 7; *Moribayashi* Fig. 33; col. 7, lines 18-20).

While the Board reversed the rejection of claim 2 as being anticipated by *Moribayashi* under 35 U.S.C. §102(b), the Board also indicates a need for the Examiner to consider rejection of claim 2 under 35 U.S.C. §112, first paragraph, for failure to comply with the written description requirement. The test at bar is whether the application, as originally filed, reasonably conveys that the inventor had possession of the later claimed subject matter.

Applicants assert that claim 2 fully complies with the written description requirement under 35 U.S.C. §112, first paragraph and compliance is demonstrated as follow. Applicants respectfully submit that the specific embodiments disclosed in the original specification are exemplary and non-limiting embodiments. Furthermore, an integral reinforcing element is analogous to specifically disclosed embodiments of the invention and such integral nature is readily appreciated by one of ordinary skill in the art.

The Examiner's attention is respectfully directed to the original specification at page 18, lines 1-3, which discloses a mold for formation of the reinforcing ring. One ordinarily skilled in the art will readily appreciate how a casting or molding of the casing/reinforcing element as an integral piece would readily follow from said disclosure.

The original specification discloses the concern of deformation of the case body where the reinforcing ring is fixed, and the desire to suppress said deformation (Application page 18, lines 7-11). MPEP §2164.01(b) entitled "How to Make the Claimed Invention" states that as long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claims, then the enablement [and possession] requirement of 35 U.S.C. §112, first paragraph, is satisfied. One ordinarily skilled in the art will readily recognize the applicability of an integrally formed reinforcement portion with respect to maintaining the integrity of the case body.

Patentability of claim 1 is duly asserted on the grounds that *Moribayashi* fails to disclose a circumferential reinforcing element which includes a cylinder portion. Cylinder is readily recognized by one of ordinary skill in the art as meaning "a three dimensional structure with two

parallel congruent circles as bases”.¹ Further, a “circle” is readily recognized to span 360 degrees. An elliptical cylinder, while having elliptical bases, still spans 360 degrees. One ordinarily skilled in the art would readily recognize that semicircle or arc span less than 360 degrees, while a circle, ring or cylinder are continuous about 360 degrees. An infinite number of sources provide an analogous definition for a cylinder as “a set of all points in space equidistant from a given line, which forms a tube with circles for both bases.”^{2, 3}

In contrast, layman’s terms such as “half-pipe” or “quarter-round” describe structures spanning 180 and 90 degrees, respectively. Referring to terms known to one of ordinary skill in the art, “arc” is a term readily recognized as “segment of a circle.”⁴ Considering the specification as a whole, and terms readily recognized by one of ordinary skill in the art, the “portion” of the term “cylinder portion” clearly refers to the circumferential wall, relative to the reinforcing element as a whole. However, for additional clarification, claim 1 is hereby amended to further describe this cylinder portion as being “continuous about a 360 degree circumference.” Applicant maintains that such additional language is not necessary to either adequately describe and particularly claim Applicant’s invention or to avoid the *Moribayashi* reference. This claim

¹ <http://fcit.usf.edu/math/resource/fcat/glossary.htm>

² http://www.nga.gov/education/classroom/counting_on_art/glossary.htm

³ <http://www.answers.com/topic/cylinder-geometry>; in common usage, a *cylinder* is taken to mean a finite section of a right circular cylinder with its ends closed to form two circular surfaces.

⁴ <http://www.answers.com/topic/arc>

amendment is made only to expedite allowance of independent claim 1 by the Examiner, and does not constitute an admission of anticipation or equivalence by *Moribayashi*.

Moribayashi fails to disclose a circumferential reinforcing element which includes a cylinder portion. Therefore, the rejection of claim 1 as being anticipated by *Moribayashi* under 35 U.S.C. §102(b) should be withdrawn.

Claims 2-4, and 6-10 are asserted as being allowable at least by virtue of their dependency upon an allowable claim.

Claims 12, 13 and 14 contain the subject matter of claims 2, 7 and 10, respectively. Said claims are asserted as being allowable by virtue of their own recitations contained therein, considering the Board's reversal of the rejections against these claims in their independent form.

In view of the preceding amendments and remarks, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue that the Examiner feels may be best resolved through a personal or telephonic interview, the Examiner is kindly requested to contact the undersigned at the local telephone number listed below.

AMENDMENT UNDER 37 C.F.R. §1.114(c)
U.S. SERIAL NO. 09/816,348

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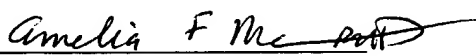
Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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CUSTOMER NUMBER


Amelia F. Morani, Ph.D.
Registration No. 52,049

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